

**REMARKS/ARGUMENTS**

The issues outstanding in the instant application are as follows:

— Claims 1 – 20 are rejected under 35 U.S.C. § 103(a).

Applicant hereby traverses the outstanding rejections, and requests reconsideration and withdrawal in light of the remarks contained herein. Claims 1 – 20 are pending in this application.

*Rejections Under 35 U.S.C. § 103(a)*

**Applicant's Response to Examiner**

U.S. Patent No. 6,369,803 to Brisebois (hereinafter *Brisebois*) teaches that “[a]ctive edge input device 120 is a user interface device positioned adjacent [to] display 110. Active edge input device 120 may actually touch display 110 or lay a predetermined distance away from an edge of display 110.” Col. 3, lns 48 – 51. The Examiner has concluded, based on this statement, that *Brisebois* teaches that it is desirable to locate the touch display *on* the display. However, this statement from *Brisebois* does not teach that the active edge input device maybe located *on* the display, only that in its position adjacent to the display, it may actually touch the display. Nowhere in *Brisebois* is there any teaching that the flexible input device is desired to be positionable *on* the display. Applicant believes that the Examiner's conclusion is not consistent with the teachings of *Brisebois*.

The Examiner additionally stated that Applicant argued that “it is desirable [in *Brisebois*] to provide an improved user interface device that is robust and ergonomically correct to create a user friendly environment that does not require ... touching the actual display.” However, while Applicant did, in fact, include this statement in the previous response, this statement is a direct quote from *Brisebois* concerning the objects of the *Brisebois* invention. Col. 2, lns 1 –4. Therefore, the Examiner's subsequent conclusion that other embodiments of *Brisebois* “require touching the actual display” is completely misplaced and completely incorrect.

In support of her conclusion, the Examiner cited to column 5, line 49 to column 6,

line 10 as purportedly describing additional embodiments of *Brisebois* that required touching the actual display. However, the material cited discusses Figures 2b and 2c of *Brisebois*, and Figures 2b and 2c describe a detailed view of the active edge input device and *not* the display. Neither the locations cited by the Examiner, nor any other discussion in *Brisebois*, teach or suggest that one possible embodiment requires the user to touch the actual display. Therefore, the teachings of *Brisebois* do not support the Examiner's conclusion that it suggests any embodiments where touching the actual display is required.

Finally, because *Brisebois* teaches away from a touch screen display, it cannot be combined with U.S. Patent No. 5,862,419 to Goto, et al., (hereinafter *Goto*), which teaches a touch panel fitted over the display, that would require the user to touch the actual display to activate the touch panel. Col. 3, lns 57 – 60. Therefore, because *Brisebois* does not teach or suggest touching an actual display and cannot be combined with *Goto*, the Examiner's rejection of the claims over *Goto* and *Brisebois* cannot be maintained.

#### **Claims 1 – 17**

Claims 1 – 17 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *Goto* in view of *Brisebois*.

#### **A Prima Facie case of obviousness has not been established.**

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art cited must teach or suggest all the claim limitations. See M.P.E.P. § 2143. Without conceding any of the criteria, Applicant asserts that the rejection does not satisfy, at least, the first and third criteria.

#### **The Office Action does not provide the requisite motivation.**

The Office Action admits that *Goto*:

does not specifically teach display [sic] comprising an electronic control system housed in association with said display, said electronic control system

including a switch platform mounted to detect a touching about a periphery of said display and to provide a plurality of discrete output signals each indicative of a portion of said periphery at which said touching is detected.

The Office Action attempts to cure this deficiency by introducing *Brisebois*, which the Office Action alleges to teach having such elements. The motivation for making the combination was presented as follows:

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the electronic control system as taught by *Brisebois* in the system of *Goto* in order to support interactive communication between a user and a user environment.

It is well settled that the fact that references can be combined or modified is not sufficient to establish a prima facie case of obviousness, M.P.E.P. § 2143.01. Such language is merely a statement that the reference can be modified, and does not state any desirability for making the modification. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990), as cited in M.P.E.P. § 2143.01. Not only does *Goto* fail to suggest the combination with *Brisebois*, but actually teaches away from the invention disclosed in *Brisebois*. Thus, the motivation provided by the Examiner is improper, as the motivation must establish the desirability for making the modification.

*Goto* discloses that the user must touch the display in order to designate the principal object to be photographed. Col. 6, lns 55 – 66. That operation enables the principal object of the invention. However, *Brisebois* defines a touch-activated user input device located near the perimeter or adjacent to the display of the device. Col. 2, lns 7 – 29. The user input device is not located on the display because *Brisebois* teaches that “it is desirable to provide an improved user interface device that is robust and ergonomically correct to create a user-friendly environment that **does not require... touching the actual display**”. Col. 2, lns 1 – 4. (emphasis added) *Brisebois* discusses that requiring the user to touch the actual display provides a less desirable interface because the user’s hand may block the view of the screen and/or the screen typically and quickly becomes dirty. Col. 1, lns 55 – 67. Thus, *Goto*’s teaching of directly touching the display teaches away from *Brisebois*’ teaching of a system to avoid directly touching the display. Therefore, the rejection of claims 1 – 17 should be

withdrawn.

The recited combination does not teach or suggest all claimed limitations.

As argued above, there is no proper motivation to combine *Goto* and *Brisebois*. However, whether taken separately or in combination, the teachings of *Goto* and *Brisebois* do not teach or suggest all limitations of the claimed invention. The Examiner already admitted that *Goto* is deficient in the majority of the elements described in the present invention. Applicant asserts that the teachings of *Brisebois* also do not teach or suggest all limitations of the claimed invention.

Claim 1 defines, in part, “a switch platform mounted to detect a touching about a periphery of said display ....” Claim 13 defines a similar limitation as, “said switching platform mounted to detect a touching about a periphery of said display ....” *Brisebois* does not disclose this limitation, as discussed above. Touching about the periphery of the display describes touching the actual display, which *Brisebois* teaches against. The active edge user input device described in *Brisebois* describes a touch-activated input device that is either near the edges of the display or is, at most, adjacent to the display. Therefore, the touch-activated input device of *Brisebois* does not teach the invention described in claims 1 and 13.

Claims 2 – 12 and 14 – 17 depend directly from base claims 1 and 13, respectively, and thus inherit all limitations of their respective base claims. Furthermore, each of claims 2 – 12 and 14 – 17 sets forth features and limitations not recited by the combination of *Goto* as modified by *Brisebois*. Thus, the Applicant respectfully asserts that for the above reasons claims 1 – 17 are patentable over the 35 U.S.C. § 103(a) rejection of record.

**Claims 18 – 20**

Claims 18 – 20 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *Brisebois* in view of obviousness.

A Prima Facie case of obviousness has not been established.

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the

knowledge generally available to one of ordinary skill in the art to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art cited must teach or suggest all the claim limitations. See M.P.E.P. § 2143. Considering the same arguments regarding the lack of motivation to combine *Goto* and *Brisebois*, Applicant further asserts that the rejection does not satisfy, at least, the third criteria.

The recited combination does not teach or suggest all claimed limitations.

Claim 18 defines, in part, “a first discrete electrical switch operable to select a displayed value in response to a touching of a central portion of said display panel ....” While the Examiner claims that it would be obvious to modify *Brisebois* to add such an element, *Brisebois* not only fails to disclose this limitation, but teaches away from touching the actual display, as discussed above. The active edge user input device described in *Brisebois* describes a touch-activated input device that is either near the edges of the display or is, at most, adjacent to the display. Therefore, the touch-activated input device of *Brisebois* does not teach the invention described in claim 18.

Claims 19 and 20 depend directly from base claim 18, respectively, and thus inherit all limitations of their respective base claims. Furthermore, each of claims 19 and 20 sets forth features and limitations not recited by the combination of *Goto* as modified by *Brisebois*. Thus, the Applicant respectfully asserts that for the above reasons claims 18 – 20 are patentable over the 35 U.S.C. § 103(a) rejection of record.

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of the claims and to pass this application to issue.

Applicant believes no fee is due with this response. However, if a fee is due, please charge Deposit Account No. 08-2025, under Order No. 10004909-1 from which the undersigned is authorized to draw.

I hereby certify that this correspondence is being deposited with the U.S. Postal Service as Express Mail, Airbill No. EV256028433US in an envelope addressed to: Mail Stop AF, Commissioner for Patents, PO Box 1450, Alexandria, VA 223013-1450, on the date shown below.

Date of Deposit: May 12, 2003

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